

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant(s)	Rene Staub et al.	Examiner:	Jamilia Williams
Serial No.:	10/521,192	Group Art Unit:	3722
Confirmation No.:	8644	Docket:	1093-120 PCT/US
Filed:	January 13, 2005	Dated:	August 10, 2009
For:	INDIVIDUALIZED SECURITY DOCUMENT		

**Board of Patent Appeals and Interferences**

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**APPEAL BRIEF PURSUANT TO 37 C.F.R. §41.37**

Sir:

This is an appeal to the United States Patent and Trademark Office Board of Patent Appeals and Interferences from a rejection of Claims 1-24 in the Office Action mailed February 6, 2009. This Appeal Brief is being submitted under the provisions of 37 C.F.R. § 41.37.

As required by 37 C.F.R. § 41.37(a)(2), please charge Deposit Account No. 082461 the fee of \$540.00, as set forth in 37 C.F.R. § 41.20(b)(2), for this Appeal Brief. If additional fees are required or if there are any overpayments, please charge or credit Deposit Account No. 082461 for such sum.

A timely Notice of Appeal was filed on June 8, 2009, thus making this Appeal Brief due August 10, 2009. This Appeal Brief is being filed in support of the Notice of Appeal.

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### **I. REAL PARTY IN INTEREST**

The real party in interest is OVD Kinegram AG, which is the assignee of the entire right, title, and interest in and to the present application.

### **II. RELATED APPEALS AND INTERFERENCES**

There are no prior or pending appeals, interferences, or judicial proceedings known to Appellant or Appellant's legal representative which may be related to, directly affect, or be directly affected by, or have a bearing on, the Board's decision in this present appeal.

### **III. STATUS OF CLAIMS**

Claims 1-17 were filed in the original application. During prosecution of the application, claims 18-24 were added and claims 1-17, 20 and 21 were amended.

Claims 1-24 are presently pending in the application and stand as being rejected in the final Office Action dated February 6, 2009. An After Final Amendment was filed May 6, 2009, pursuant to 37 CFR §1.116, cancelling dependent Claim 4 and incorporating all the limitations therein into the independent claims. An Advisory Action issued May 26, 2009 indicating that those after final amendment would not be entered by the Examiner. However, as Appellant believes such amendments materially reduce the issues on appeal, those same amendments are hereby presented again with this appeal brief, pursuant to 37 CFR §41.33(b)(2). Thus, the claims being appealed are Claims 1-3 and 5-24 as presented in the Claims Appendix.

### **IV. STATUS OF AMENDMENTS**

In response to the final rejection mailed February 6, 2009 an amendment pursuant to 37 CFR §1.116 was presented by Applicants on May 5, 2009, however those amendments were not entered by the Examiner, as indicated in the Advisory Action issued May 26, 2009. Subsequently, a Notice of Appeal was filed on June 8,

2009 without further amendments or arguments. No further amendments or responses were filed subsequent to the filing of the Notice of Appeal, until the filing of this brief which includes the same amendments presented by Applicants on May 5, 2009.

## **V. SUMMARY OF CLAIMED SUBJECT MATTER**

The following is a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, with reference to the specification by page and line number. Claims 1 and 21 are the independent claims on appeal.

The present invention as set forth in independent claim 1 is directed to an individualized security document (specification, p. 1, lines 2-4). The security document includes a number of pages joined together by a means of fixing or adhesive (specification, p. 1, lines 4-6). Incorporated into the security document by the previously recited “means of fixing or adhesive” is a transfer film with security elements (specification, p. 5, lines 31-32). The transfer film is provided with a base film permanently connected to a carrier film by means of a permanent adhesive and a decorative layer arrangement temporarily connected by means of a release layer to the carrier film (specification, p.7, line 31 to p. 8, line 6; p. 8, line 29 to page 9, line 14, as well as Fig. 7). The decorative layer arrangement is provided with security elements (specification, p. 6, lines 1-4) and an adhesive layer on a side remote from the base film (specification, p. 10, lines 13-22, as well as Fig. 7).

The present invention as set forth in independent claim 21 is directed to a security document (specification, p. 1, lines 2-4). The security document includes a plurality of individual pages joined to form a book by a means of fixing (specification, p. 1, lines 2-6). The security document also comprising at least one transfer film joined to one of the pages by the previously recited “fixing means” (specification, p. 5, lines 31-32). The transfer film includes a base film permanently connected to a carrier film by means of a permanent adhesive and a decorative layer arrangement temporarily connected by means of a release layer to the carrier film (specification, p.7, line 31 to p. 8, line 6; p. 8, line 29 to page 9, line 14, as well as Fig. 7). The

decorative layer arrangement is provided with security elements (specification, p. 6, lines 1-4) and an adhesive layer on a side remote from the base film (specification, p. 10, lines 13-22, as well as Fig. 7).

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The grounds of rejection are to be reviewed on this appeal:

- I. Whether Claims 1-4, 6-9, 16-17 and 21, are unpatentable under 35 U.S.C. §103(a) over U.S. Patent No. 6,808,792 to Weber (hereinafter “Weber”) in view of Garrard.
- II. Whether Claims 10-15, 18-20 and 22-24 are unpatentable under 35 U.S.C. §103(a) over Weber and Garrard and further in view of U.S. Patent No. 4,533,160 to Malone (hereinafter “Malone”).

## **VII. ARGUMENT**

- I. Rejection of Claims 1-4, 6-9, 16-17 and 21 under 35 U.S.C. §103(a) as being unpatentable over Weber in view of Garrard.

As the amendments submitted herewith incorporate all the limitations of dependent Claim 4 into independent Claims 1 and 21, the arguments presented herein still apply to the pending rejection of Claims 1-4, 6-9, 16-17 and 21.

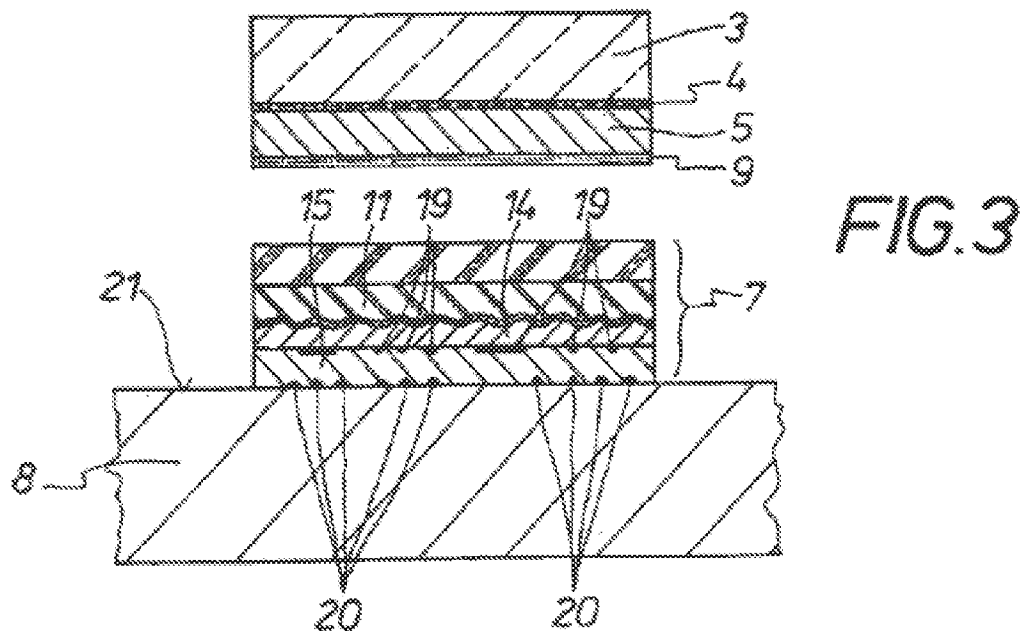
Appellant respectfully appeals because, *inter alia*, the subject Office Action impermissibly combines Weber and Garrard in an attempt to arrive at a *prima facie* case of obviousness.

It is well settled that a rejection for obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

Also, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned from applicant's disclosure, such a reconstruction is proper." *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971). See also, *Radix Corp. v. Samuels*, 13 USPQ2d 1689, 1693 (D.D.C. 1989). The fact finder must be aware "of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 36 (1966) (warning against a "temptation to read into the prior art the teachings of the invention in issue")).

Further, in establishing a *prima facie* case of obviousness, the cited references must be considered for the entirety of their teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). It is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.*

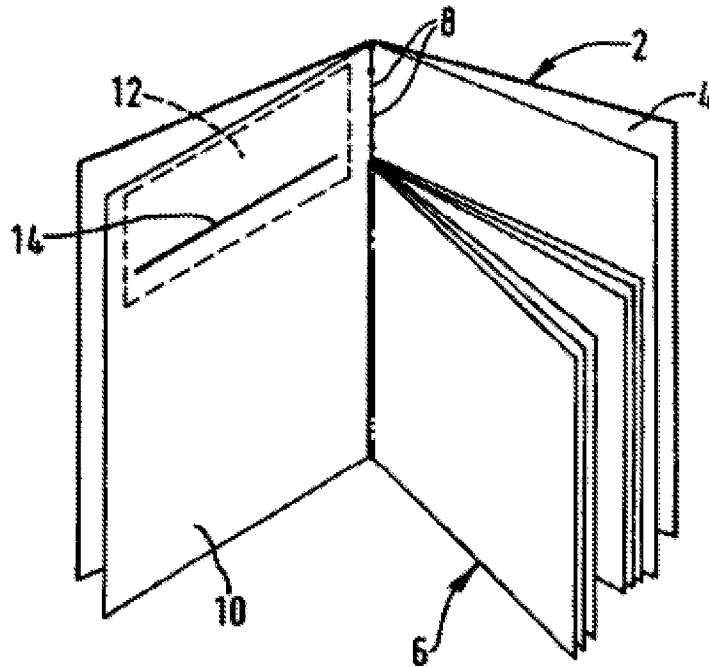
Weber discloses a transfer film that is label-like in that it has a film layer that is carried by a base that separates after the film layer is secured to a substrate. In particular, the Weber transfer film includes a base film (3) permanently connected to a carrier film (5) by means of a permanent adhesive (4) and a decorative layer arrangement (7) temporarily connected by means of a release layer (9) to the carrier film (5). The decorative layer arrangement (7) includes security elements and an adhesive layer (15) on a side remote from the base film (3). Weber also discloses that such a transfer film can be used to apply to the decorative layer arrangement (7) to cover a full page of a security document (passport, substrate 8). Fig. 3 of Weber is shown below with the decorative layer arrangement (7) secured by adhesive (15) to substrate (8) and the base film (3) and carrier film (5) separated therefrom.



It is conceded in the Office Action at page 3 that Weber does not disclose the security document (passport, substrate 8) having a number of pages and the entire transfer film, including the base film (3) and carrier film (5), joined together by the same means of fixing or adhesive as the other pages. In other words, in Weber the adhesive layer (15) is applying to a page of the document (passport, substrate 8), thereby adhering the decorative layer arrangement (7) thereto; then everything above the release layer (9) is separated from the decorative layer arrangement (7). Thus in Weber, no part of the transfer film is secured by the same means of fixing as the pages forming the passport, and the base film (3) and carrier film (5) are only momentarily attached to the document.

Garrard is cited in the Office Action for teaching a security document (passport) having a number of pages (6) and including sheet (10) joined by a common fixing (stitches 8). In Garrard, a pressure sensitive UV material is coated on the back of one of the sheets (10) in area (12) so that a customer can sign the front of that sheet (10) and transfer the impression of their signature in UV material to the inside cover of

the book, like carbon paper. The UV material is not visible to the naked eye and acts like an invisible ink. The only illustration from Garrard is shown below.



Thus, the subject Office Action rejection indicates that “[i]t would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pages and binding or fixing of Garrard with the passport of Weber for the purpose of securing various amounts of information together in the passport.”

The above rationale, given as a basis to combine Weber and Garrard, is inapplicable to the cited patents and does not clearly articulate a rational basis to combine the two disclosures as suggested in the action. The disclosure of Weber alone “secures” various amounts of information together in a passport by applying a whole layer of material in the form of a security seal (a decorative layer arrangement), like a sticker or a label, over personal data on the page of a passport. The transfer foil of Weber alone does not contain “information” per se, but includes a decorative layer that after being applied to a document and having the base film removed is a safeguard for information contained in a document. Thus, “securing various amounts of information” would not be a reason or



motivation to secure the base film of Weber into a passbook. So absent the knowledge gleaned from the subject disclosure, what motivation would one have to stitch or bind the base film to the security document? Weber does not disclose or reasonably suggest any need for precision in placement of the transfer foil or the decorative layer arrangement, because the security seal likely covers varied amounts and kinds of personal data. Also, the Weber transfer film is easy to apply, so there is no reason to add additional support to hold it in place. Thus, absent the teachings of the subject invention, one of ordinary skill would have no reason or motivation to bind the Weber transfer film, including the base film and the decorative layer arrangement, together with a plurality of individual pages. In fact, one of the main aspects of Weber is to avoid “a high level of machine expenditure” in applying a hot stamping foil to such a document (see, Weber Col. 5, lines 35-45). The Examiner’s suggestion of having the Weber transfer foil bound into the passbook would invariably increase production costs and thus runs contrary to the explicit teachings of Weber.

Alternatively in the Advisory Action, the Examiner opines that “Garrard teaches having a security document having a number of pages and transfer film joined by stitching” and that merely because both Garrard and Weber relate to “types of transfer films” that it would have been obvious to one having ordinary skill in the art to arrive at the claimed invention, although no further motivation or reason to do so is provided. Thus, the Office Action picks and chooses that Garrard teaches any transfer film being bound with other pages, rather than the more complete disclosure of an invisible ink transfer system disclosed therein. It should be noted that the so called “transfer film” of Garrard transfers a signature into document (more akin to carbon paper). In contrast, to the transfer film of Weber transfers an entire decorative web (layer) used to cover a signature or other personal information already printed in the security document to which it is applied (more akin to a sticker or label). The security sheet (10) in Garrard has a different purpose and function from the transfer foil of Weber and they are not interchangeable.

The reason cited in the Office Action for combining Weber and Garrard is also inapplicable to one of ordinary skill starting from the Garrard passbook and looking to alter it. As disclosed in Garrard, the security sheet (10) includes a pressure sensitive coating of UV fluorescing material in order to provide a means of applying an account holder's signature to a passbook in a way that is not visible to the naked eye. To replace the security sheet of Garrard with a different transfer film not intended to transfer a signature would make it inoperable for its intended purpose. Even if one were to attempt to use the Weber transfer foil in place of the Garrard security sheet, it would not be possible to transfer a portion of the Weber foil in the areas where pressure is applied with a pen. It should be noted that Garrard is not concerned with tamper-resistance or safeguarding the structural integrity of a document, but rather is focused on concealing information therein. The decorative layer arrangement of Weber does not conceal information and does not provide a means of transferring one's signature.

Further, the reason explicitly recited in Garrard for stitching the security sheet (10) into the passbook (2) is because it "is difficult to keep [a UV transfer strip] in place over the signature area when it is being written on by a variety of writing instruments." In contrast, there is no disclosure or reasonable suggestion that the Weber transfer foils are difficult to keep in place when applying them to a security document. In fact, Weber explicitly discloses its transfer foil "enjoys the necessary stability so that the transfer foil can be handled neatly and tidily even without expensive machines" (see Weber, col. 2, lines 49-56). Thus, the same reason or motivation disclosed in Garrard for securing the sheet (10) does not apply to just any type of transfer film.

In the present appeal, it is apparent that the examiner has used the knowledge gleaned from applicant's disclosure as the very motivation to combine the two cited patents. The Office Action fails to address the fact that Weber does not disclose a need or desire to join the transfer foil, including the removable base film, to the passport or other security document. Nor does Weber disclose a need for the decorative layer arrangement of a hot stamping foil to be held in-place or

aligned within a passport with exquisite precision. Additionally, the Examiner may not properly pick one aspect of fixing a security sheet from Garrard and then ignore why that particular type of sheet was joined therein. Similarly, the Examiner may not properly pick the teaching of a particular type of transfer film as taught by Weber and substitute that film in place of the non-equivalent invisible ink signature transfer system as taught by Garrard, without showing a known reason to do so. When assessing the knowledge of one of ordinary skill at the time the subject invention was made, the particular applications and limitations of the teachings of Weber and Garrard must be considered by the examiner.

Thus, Weber and Garrard fail to teach or reasonably suggest the present invention because these references may not be properly combined in an attempt to present a *prima facie* case for obviousness. Accordingly, independent Claims 1 and 21, as amended herein, are patentably distinct over Weber and Garrard. Therefore, reconsideration and withdrawal of the rejection of Claims 1, 21 and all claims dependent therefrom, under 35 U.S.C. §103(a) are respectfully requested.

II. Rejection of Claims 10-15, 18-20 and 22-24 under 35 U.S.C. §103(a) as being unpatentable over Weber and Garrard and further in view of Malone.

Appellant respectfully appeals because, *inter alia*, the subject Office Action impermissibly combines Weber, Garrard and Malone in an attempt to arrive at a *prima facie* case of obviousness.

The basis for this rejection in the Office Action is as follows:

**Weber modified by Garrard does not however disclose the base film is provided with a perforation.**

**Malone discloses a book having layered sheets that are separated via perforations (24). In that the base film is part of the**

**sheet bound in the book as taught by Weber modified by Garrard, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the perforations as taught by Malone with the sheet of Weber modified by Garrard for the purpose for allowing for removal from the book.**

**Regarding claims 11 - 14, Weber modified by Garrard and Malone discloses perforations in layered sheets. Regarding the specific arrangement of the perforations, in that it is known to have perforations to separate the wanted portions of a sheet (or layers hereof) it would have been obvious to one having ordinary skill in the art at the time the invention was made to vary the position of the perforation as a matter of design choice. Additionally, the positioning of the perforation would have been obvious because applying a particular known technique to improve similar devices in the same way is recognized as part of ordinary capabilities of one skilled in the art.**

In the rejection of Claims 10-15, 18-20 and 22-24, the Office Action exemplifies how the subject invention is being used as a guide-map for assembling the prior art. The arguments set forth above with regard to independent Claims 1 and 21 apply equally to these dependent claims. Further, distinguishing elements not taught by the prior art and recited in Claims 12, 14, 18 and 22 are discussed below:

Claims 14, 18 and 22

Additionally, Claims 14, 18 and 22 are examples of the subject matter not taught or reasonably suggested by the prior art. Claim 14 recites that the transfer film perforations are disposed laterally displaced with respect to the fixing or adhesive. Claims 18 and 22 similarly recites that a portion of the base film is intended to remain fixed to the security document. In this regard, Garrard explicitly discloses that after the sheet (10) is removed, there should be “no strips of paper adjacent to the line of stitches which might interfere with the apparatus often used in financial institutions to

feed the flattened-out passbook to a read/write station”. Thus, contrary to this explicit teaching, the Examiner opines that it would have been obvious to combine the teachings of Garrard with that of a general notebook having offset perforations in the sheets as disclosed by Malone. Garrard clearly teaches away from such a combination. In fact, Garrard clearly teaches away from varying the position of any perforations in the sheet (10), since Garrard explicitly teaches that no portion of the sheet (10) should remain after it is removed.

#### Claim 12

Additionally, Claims 11 and 12 of the subject application recite two mutually exclusive alternatives to what elements the perforations pass through. In Claim 11 the perforations pass through the base film and not the decorative layer arrangement. However, in Claim 12 the perforations pass through the decorative layer arrangement as well. There is clearly no teaching in the art of placing perforations in a portion of the decorative layer arrangement intended to be secured within a document. The Office Action fails to address this limitation or provide an articulated reason for providing such a feature.

Thus, the combination of Weber, Garrard and Malone fail to teach or reasonably suggest the present invention because these references may not be properly combined in an attempt to present a prima facie case for obviousness. Accordingly, Claims 10-15, 18-20 and 22-24, as amended herein, are patentably distinct over Weber, Garrard and Malone. Therefore, reconsideration and withdrawal of the rejection of Claims 10-15, 18-20 and 22-24 under 35 U.S.C. §103(a) are respectfully requested.

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Conclusion

For the foregoing reasons, the invention of claims 1-3 and 5-24 are patentably distinct from the combination of references cited in the Office Action of February 6, 2009. Appellant respectfully requests reversal of the rejections of claims 1-3 and 5-24, as amended herein.

Respectfully submitted,

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### **VIII. CLAIMS APPENDIX**

The claims involved in the Appeal are:

1.       **(Currently Amended)** An individualized security document comprising:  
  
          a number of pages joined together by a means of fixing or adhesive, wherein incorporated into the security document by the means of fixing or adhesive is a transfer film which is provided with security elements and which has a base film and a decorative layer arrangement which is provided with the security elements, the base film being releasably secured to the decorative layer arrangement, the decorative layer arrangement having an adhesive layer on a side remote from the base film, wherein the decorative layer arrangement having security elements is temporarily connected by means of a release layer to a carrier film which is permanently connected to the base film by means of a permanent adhesive.
2.       (Previously presented) An individualized security document as set forth in claim 1, wherein the base film of the transfer film provided with security elements comprises a transparent or non-transparent plastic material.
3.       (Previously presented) An individualized security document as set forth in claim 1, wherein the base film of the transfer film which is provided with security elements comprises paper.
4.       (Canceled)
5.       (Previously presented) An individualized security document as set forth in claim 3, wherein the base film has at least one window opening.
6.       (Previously presented) An individualized security document as set forth in claim 1, wherein the decorative layer arrangement is applied in the form of a label to the base film or to the carrier film which is permanently connected to the base film.
7.       (Previously presented) An individualized security document as set

forth in claim 1, wherein the decorative layer arrangement is laminated onto the base film or onto the carrier film which is permanently connected to the base film.

8. (Previously presented) An individualized security document as set forth in claim 1, wherein the decorative layer arrangement is transparent or partially transparent.

9. (Previously presented) An individualized security document as set forth in claim 1, wherein the base film and/or the carrier film is provided with markings and/or numberings.

10. (Previously presented) An individualized security document in particular as set forth in claim 1, wherein at least the base film is provided with a perforation for cutting out the base film or the base film with the carrier film permanently connected thereto.

11. (Previously presented) An individualized security document as set forth in claim 10, wherein the perforation is provided only in the base film and the decorative layer arrangement is laterally spaced from the perforation.

12. (Previously presented) An individualized security document as set forth in claim 10, wherein the perforation extends through the base film and through the decorative layer arrangement.

13. (Previously presented) An individualized security document as set forth in claim 10, wherein the perforation of the transfer film having security elements is provided in coincident relationship with the fixing or adhesive of the security document and the transfer film provided with security elements is fixed by means of the fixing or adhesive in the security document.

14. (Previously presented) An individualized security document as set forth in claim 10, wherein the perforation of the transfer film having security elements is disposed laterally displaced with respect to the fixing or adhesive of the security document and the edge region of the transfer film, which edge region is defined by the



perforation, is fixed in the security document by means of the fixing or adhesive in such a way that a base film strip remains on both sides of the fixing.

15. (Previously presented) An individualized security document as set forth in claim 14, wherein the base film comprises a security paper having security features.

16. (Previously presented) An individualized security document as set forth in claim 1, wherein the transfer film provided with security elements is of surface dimensions adapted to a page of the security document.

17. (Previously presented) An individualized security document as set forth in claim 1, wherein the transfer film provided with security elements is of surface dimensions adapted to a double page of the security document.

18. (Previously presented) An individualized security document as set forth in claim 1, wherein the transfer film includes a means for separating a portion of the base film away from the security document, wherein at least another portion of the base film remains on the security document after the portion of the base film is separated away from the security document along the separation means.

19. (Previously presented) An individualized security document as set forth in claim 18, wherein the means for separation includes at least one perforation through the transfer film.

20. (Previously presented) An individualized security document as set forth in claim 18, wherein the separation means is included on at least one of the base film and the decorative layer arrangement..

21. **(Currently Amended)** A security document comprising:  
a plurality of individual pages joined to form a book by a means of fixing,  
at least one transfer film joined to one of the pages by the fixing means, the transfer film including a base film and a decorative layer arrangement, the base film being releasably secured to the decorative layer arrangement, ~~wherein~~ the decorative

layer arrangement including at least one security element temporarily connected by means of a release layer to a carrier film which is permanently connected to the base film by means of a permanent adhesive, and further wherein on a side remote from the base film the decorative layer arrangement includes an adhesive layer.

22. (Previously presented) A security document as set forth in claim 21, wherein the transfer film includes a means for separating a portion of the base film away from the security document along the separation means, such that upon separation of the portion of the base film from the security document, another portion of the base film remains fixed to the security document.

23. (Previously presented) A security document as set forth in claim 22, wherein the separation means includes at least one perforation.

24. (Previously presented) A security document as set forth in claim 21, wherein the separation means is included on at least one of the base film and the decorative layer arrangement.

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## **IX. EVIDENCE APPENDIX**

There were no declarations or other evidence submitted during the prosecution of this application.

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**X. RELATED PROCEEDINGS APPENDIX**

None.